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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,957	12/14/2001	Gary M. Rapps	CM02023K	7541

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EXAMINER
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NI, SUHAN

ART UNIT	PAPER NUMBER
2643	13

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/017,957

Applicant(s)

RAPPS, GARY M.

Examiner

Sinh Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 13.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer (DE 20009908, published 8/31/00; English translation of DE 20009908 is provided by US 2002/0172386) in view of Taenzer et al. (6,009,183).

Regarding claims 1-5, 7, 9, Bayer discloses a communication device for use behind an ear (BTE, see [0001] and [0042]), comprising a housing (it is inherent that the BTE has a housing to house all the electronic circuitries, e.g. microphone, loudspeaker and etc.); a sound delivery tube (42) coupled to the housing (see abstract, lines 1-5); and a self-retaining element (20 of Figs. 1-5; Figs. 8-9; 364 of Figs. 12-15; 460, Fig. 17; 560 of Fig. 20, and Figs. 22-25) rests beneath an inferior crus of the ear and provides positive retention of the device to the ear ("the surface structure of the main body, with its multiple curves, is clearly evident; this is responsible for the accurate fit and secure seat in the cymba conchae, which prevents it from being moved" [0051]) when the sound tube is positioned for non-occluded sound delivery to the ear. Bayer, however fails to specifically disclose that the sound delivery tube is being a one size tube that fits substantially all ear shapes and sizes. On the other hand, Taenzer et al. discloses a BTE

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communication device having a sound delivery tube (14) which is a one size tube that fits substantially all ear shapes and sizes (col. 4, lines 8-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the sound delivery tube of Taenzer et al in place of the sound tube of Bayer for the purpose of providing a sound tube that fits substantially all ear shapes and sizes.

Regarding claims 6, 10-12, the combination of Bayer in view of Taenzer et al. further discloses that the self-retaining element comprises spring properties, flexible or semi-rigid ([0045] of Bayer) and is constructed from a material consisting of: rubber, plastic and metal ([0044] and [0054] of Bayer).

Regarding claim 13, Bayer in view of Taenzer et al. further discloses that the self-retaining element, when positioned on the ear, applies positive retention across the pinna of the ear between the sulcus and the concha (“part 156 provides the hold, which is shaped to fit into the cyma conchae 50”, [0049] and “its multiple curves, is clearly evident is responsible for the accurate fit and secure seat in the cyma conchae, which prevents it from being moved” [0051] in Bayer).

3. Claims 1, 8 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taenzer et al. in view of Bayer.

Regarding claim 1, Taenzer et al discloses a communication device for use behind the ear comprising a housing (22); a sound delivery tube (14) being a one size tube that fits substantially all ear shapes and sizes (col. 4, lines 8-10). Taenzer et al fails to disclose a self-retaining element as recited in lines 5-9 in the claim. However, Bayer teaches a communication device for use behind the ear with a self-retaining element (20) coupled to the housing, wherein the self-retaining element (20 of Figs. 1-5; 364 of Figs.

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12-15; 460, Fig. 17; 560 of Fig. 20, and Figs. 22-25) rests beneath an inferior crus of the ear and provides positive retention of the device to the ear (stabilization of the sound tube in the region of the entrance to the auditory canal-[0059] and reference 461 refers to a sound tube eye that stabilized a sound tube 428, [0061]) when the sound tube is positioned for non-occluded sound delivery to the ear. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the communication device of Taenzer with the self-retaining element as taught by Bayer for the purpose of providing additional stabilization of the communication device on the ear.

Regarding claim 8, the combination of Taenzer et al in view of Bayer fails to specifically disclose that the self-retaining element is molded onto the sound delivery tube. However, Taenzer et al teaches that an 'entire sound delivery tube 14, connector 30, and ear tip 16 may be molded together as a single piece from a single material. Alternatively, the connector 30 and ear tip 16 may be connected to the sound delivery tube 14 by over-molding", col. 5. lines 36-41. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the over molding technique of Taenzer et al to the communication device of the combination to implement the required joining of the sound tube to the retaining element.

Regarding claims 14-15, the combination of Taenzer et al. in view of Bayer teaches that the communication device is wireless or wired (wired cable 20 or can be implemented as wireless, see col. 2, last paragraph of Tzenzer et al).

Regarding claim 16, the combination of Tazenaer et al. in view of Bayer disclosed that the BTE housing has a first section that rests on a sulcus of the ear, and wherein the

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positive retention of the communication device to the ear results from a space between the first section of the housing and the self-retaining element (Fig. 1 of Tazenaer et al).

Regarding claims 17-18, the combination of Tzenzer et al. in view of Bayer discloses that the dimension across the space between the first section of the housing and the self-retaining element is .118 inches +/- .054 (firstly, the BTE housing 10 shown by Taenzer et al. is incorporated by reference by the present applicant, see page 1 of the present disclosure, therefore, the dimension of the housing is approximately the same. Secondly, the dimension across the space between the first section of the housing and the retaining element would be around .118inches +/- .054 since the dimension of the first section of the housing on the ear curving around to near the ear canal would have approximately such dimension for an average ear dimension).

### ***Response to Arguments***

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.
2. Regarding the applicant's questioning the appropriateness of the term "otoplasty" in Bayer reference. The applicant should refer to DE 3618002, published 1/28/88; DE 3826897, published 3/30/89; and WO 9211737 published 7/9/92 for further background knowledge.
3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

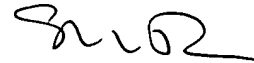
#### *Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sinh Tran whose telephone number is (703) 305-4040. The examiner can normally be reached on M,T&Th 9:00AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sinh Tran  
Primary Examiner  
Art Unit 2643

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